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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,785	03/06/2002	Michael J. O'Donnell	14-526 C1	9394

7590

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EXAMINER

CLARKE, SARA SACHIE

ART UNIT

PAPER NUMBER

3749

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/091,785

Applicant(s)

O'DONNELL ET AL.

Examiner

Sara Clarke

Art Unit

3749

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004 and 28 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings were received on June 3, 2004. These drawings are approved.

### ***Specification***

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(f) he did not himself invent the subject matter sought to be patented.

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

#### ***U.S. Patent No. 6,371,753***

Claims 1-4 and 7-10 are rejected under 35 U.S.C. 102(f&g)/103(a) as being

unpatentable over O'Donnell et al. (US 6371753) in view of Nolte et al. (US 6027336).

O'Donnell et al. discloses the invention substantially as claimed with the exception of a source of primary air under pressure.

Nolte et al. discloses a tube burner and teaches the use of a source of primary air under pressure from fan 12 for the purpose of the amount of primary air being determined essentially by the blower. See the bottom of column 1 and the top of column 2.

Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide the burner of O'Donnell et al. with a source of primary air under pressure as taught by Nolte et al. for the purpose of the amount of primary air being determined essentially by the blower.

With respect to claim 10, it has been held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. See MPEP 2144.04(VI)(B). In this case, providing a second dimple downstream from the first amounts to a mere duplication of the first dimple and thus would have been obvious to one of ordinary skill in the art. Providing additional mixing of fuel and air is not a new or unexpected result.

Claim 13 is rejected under 35 U.S.C. 102(f&g)/103(a) as being unpatentable over O'Donnell et al. (US 6371753) in view of Anderson (US 3269165).

O'Donnell et al. discloses the invention substantially as claimed with the exception of the flame ports including inwardly bent tabs.

Anderson discloses a tube burner and teaches the use of flame ports including inwardly bent tabs to provide maximum burner efficiency. See column 1.

Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide the burner of O'Donnell et al. with flame ports including inwardly bent tabs as taught by Anderson for the purpose of providing maximum burner efficiency.

Claims 1-4, 7-10, and 13 are directed to an invention not patentably distinct from claims 1 and 4-6 of commonly assigned U.S. Patent No. 6,371,753. Specifically, in claims 1 and 4-6 of U.S. Patent No. 6,371,753, the invention is recited as claimed with the exception of a source of primary air under pressure and flame ports including inwardly bent tabs.

With respect to Nolte et al., see above. With respect to Anderson, see above.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide the burner of claims 1 and 4-6 of U.S. Patent No. 6,371,753 with a source of primary air under pressure as taught by Nolte et al. for the purpose of the amount of primary air being determined essentially by the blower. With respect to claim 10, see the reasoning above. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide the burner of claim 1 of U.S. Patent No. 6,371,753 with flame ports including inwardly bent tabs as taught by Anderson for the purpose of providing maximum burner efficiency.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). The commonly assigned patent to O'Donnell et al., discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the

conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Claims 1-4 and 7-10 are rejected under 35 U.S.C. 102(e)/103(a) as being obvious over O'Donnell et al. (US 6371753) in view of Nolte et al. (US 6027336). Claim 13 is rejected under 35 U.S.C. 102(e)/103(a) as being obvious over O'Donnell et al. (US 6371753) in view of Anderson (US 3269165).

O'Donnell et al. (US 6371753) has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the

application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2). For the explanations of obviousness, see the rejections under 35 U.S.C. 102(f&g)/103(a) above.

***Allowable Subject Matter***

Claim 15 is allowable.

***Response to Amendments/Arguments***

In applicant's response, applicant states, "It should be noted here that in the Office Action the Examiner acknowledges that the subject application and the '753 patent, which was cited in the rejection, are commonly owned." This assumption does not overcome the rejections made under 102(e), (f), or (g)/103(a). These rejections can be overcome by a statement of common ownership at the time of invention. See MPEP 706.02(I). How to overcome the 102(e)/103(a) rejection is described in the rejection itself.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not


mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Contact Information**

Any inquiry concerning this or earlier communications from the examiner should be directed to Sara Clarke whose phone number is 703-308-1388. The examiner normally can be reached Mon-Fri, 8:30-1:00.

If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Ira Lazarus can be reached at 703-308-1935. The fax number for the organization where this application is assigned is 703-872-9306.

Status information for an application is available from the Patent Application Information Retrieval (PAIR) system. Status information for published applications is available from Private or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about PAIR, see <http://pair-direct.uspto.gov>. For questions on access to Private PAIR, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sara Clarke   
Primary Examiner  
Art Unit 3749

October 13, 2004